

REMARKS

In the Office Communication dated October 15, 2006, the Examiner stated:

The reply filed on August 4, 2006 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): The declaration pursuant to 37 C.F.R. § 1.131 is defective because the signature of at least one of the inventors is missing (Re: Qi Xiang). See 37 C.F.R. 1.111.

A 37 C.F.R. § 1.47(a) petition was filed on August 4, 2006 (along with the reply) in which the Applicants requested that the Commissioner treat the present application as being made by inventors James N. Pan and Jung-Suk Goo on behalf of non-signing inventor Qi Xiang. A copy of the petition is attached for the Examiner's reference.

The petition was granted, as indicated by a decision mailed from the PTO on September 13, 2006. A copy of the decision is also attached for the Examiner's reference.

Accordingly, the Applicants submit that the reply filed on August 4, 2006 is fully responsive to the prior Office Action and respectfully request that the Examiner enter and consider the reply.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date 10/30/2006

FOLEY & LARDNER LLP
Customer Number: 34083
Telephone: (313) 234-7150
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By 

Marcus W. Sprow
Attorney for Applicants
Registration No. 48,580

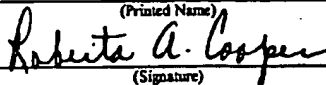


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Atty. Dkt. No. 039153-0693 (H1718)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Xiang et al.
Title: SHALLOW TRENCH
ISOLATION PROCESS
AND STRUCTURE
WITH MINIMIZED
STRAINED SILICON
CONSUMPTION
Appl. No.: 10/755,602
Filing Date: 01/12/2004
Examiner: Jack Chen
Art Unit: 2813
Confirmation No.: 9549

CERTIFICATE OF EXPRESS MAILING	
I hereby certify that this correspondence is being deposited with the United States Postal Service's "Express Mail Post Office To Addressee" service under 37 C.F.R. § 1.10 on the date indicated below and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.	
EV 904367259 US	08/04/06
(Express Mail Label Number)	(Date of Deposit)
Roberta A. Cooper	
(Printed Name)	
	
(Signature)	

PETITION UNDER 37 C.F.R. 1.47(a)

Mail Stop PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition the Commissioner under 37 C.F.R. § 1.47(a) and 35 U.S.C. § 116 to treat the above-identified patent application as being made by inventors James N. Pan and Jung-Suk Goo on behalf of non-signing inventor Qi Xiang.

Inventor Qi Xiang was employed by Advanced Micro Devices, Inc. at the time of the filing of the present application. Mr. Xiang executed the Declaration and Power of Attorney form that accompanied this application, and has assigned his rights in the invention to Advanced Micro Devices, Inc., as indicated by an Assignment document recorded in the records of the U.S. Patent and Trademark Office at Reel/Frame 014896/0990.

Inventor Xiang has since left the employment of Advanced Micro Devices, Inc., and attempts to reach him by the undersigned attorney have been unsuccessful.

A Statement of Facts signed by the undersigned attorney in support of this petition is provided herewith, and includes the last known home and business addresses for inventor Xiang.

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03 FC:1464

Adjustment date: 09/13/2006 CKHLOK
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Atty. Dkt. No. 039153-0693 (H1718)

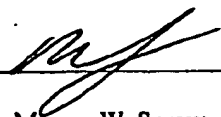
A check in the amount of \$130.00 is provided herewith in payment of the petition fee pursuant to 37 C.F.R. § 1.17(h).

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447.

Respectfully submitted,

Date 8/4/06

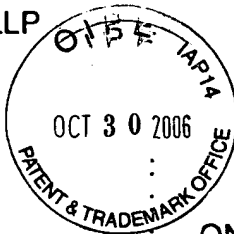
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AMD-MKE C/O FOLEY LARDNER LLP
777 EAST WISCONSIN AVENUE
MILWAUKEE WI 53202-5306In re Application of
Qi Xiang et al.
Application No. 10/755,602
Filed: January 12, 2004
Attorney Docket No: 039153-0693(H1718)

ON PETITION

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OFFICE OF PETITIONS

This is a decision on the petition under 37 CFR 1.47(a) filed August 4, 2006, which is being treated as a petition under 37 CFR 1.183 seeking waiver of 37 CFR § 1.131 where it requires that an affidavit be executed by the named inventors.¹

The petition under 37 CFR 1.183 is **GRANTED**.

The above-identified application was filed on January 12, 2004. At the time of filing, applicant submitted a 37 CFR 1.63 declaration signed by all of the inventors. A non-final Office action was mailed on April 6, 2006. This office action set a shortened statutory period for reply of three months.

In response, on June 16, 2005, with a one month extension of time, applicant submitted a reply and a declaration under 37 CFR 1.131. The 37 CFR 1.131 declaration stated that all of the inventors were responsible for reduction to practice of the subject matter of the rejected claims prior to the date of the reference on which the April 6, 2006 rejection was based. However, the 37 CFR 1.131 declaration was signed by all joint inventors except joint inventor Qi Xiang. Applicant has filed the instant petition to have the 37 CFR 1.131 declaration entered despite the fact that the declaration was not signed by joint inventor Xiang.

37 CFR 1.131 states, in pertinent part:

When any claim of an application or a patent under reexamination is rejected, the **inventor** of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based.²

In addition, the Manual of Patent Examining Procedure states that "an application or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter

¹ Once an application has received a fully executed oath or declaration and been placed on the files for examination, the provisions of 37 CFR 1.47 no longer apply.

² 37 CFR 1.131(a) (emphasis added).

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of the claim or claims under rejection."³

Here, there has not been a party qualified under 37 CFR 1.42, 1.43, or 1.47. In addition, the instant application is not the subject of a patent under reexamination. Moreover, it has not been shown that less than all of the named inventors of the application invented the subject matter of the claims under rejection. Accordingly, the only party eligible to sign the 37 CFR 1.131 declaration are all of the joint inventors including Xiang.

The petition bears proof that the declaration was mailed to Mr. Xiang at his last known address but in spite of the effort to have it executed, Mr. Xiang has failed to comply with the request.

In order for a petition under 37 CFR 1.183 to be granted, petitioner must demonstrate that this is an extraordinary situation where justice requires waiver of the rules.

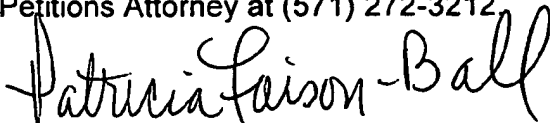
The 37 CFR 1.131 declaration was required to be signed by all joint inventors but all except joint inventor Xiang have executed it. Applicant has demonstrated that a *bona fide* effort was made to have Mr. Xiang execute the declaration. Accordingly, it is concluded that petitioner has demonstrated that this is an extraordinary situation requiring waiver of the rules.

The 37 CFR 1.131 declaration will be entered, despite the fact that its requirement that all of the inventors sign the declaration has not been satisfied.

It should be noted however, that effective November 22, 2004, the fee for a petition to waive the rules has been increased to \$400.00. Therein, deposit account no. 06-1447 has been charged in the amount of \$270.00 pursuant to 37 CFR 1.17(f), to make up the difference between that which was paid and that which was due. See the Notice published in the Federal Register on September 21, 2004 and in the Official Gazette of the United States Patent and Trademark Office on October 12, 2004.

The application file is being forwarded to Technology Center 2813 for consideration of the reply and the 37 CFR 1.131 declaration, filed August 4, 2006.

Telephone inquiries related to this decision should be directed to the undersigned Petitions Attorney at (571) 272-3212.



Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

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³ MPEP 715.04.

Please direct all correspondence to the undersigned attorney or agent at the address indicated below.

Respectfully submitted,

Date 10/30/2006

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